

10/057,099

-8-

A0000247-01-MG

REMARKS*Claim disposition.*

Claims 1-3, 5, 6, 10, and 19 to 23 are pending in the application. Claims 1, 19, and 20 are amended in this paper.

Specification

A. The specification is amended as set forth above, and as suggested by the Examiner, to recite Figures 3A and 3B. Accordingly, the withdrawal of this objection is respectfully requested.

B. It is acknowledged that outstanding objections to the drawings are deferred until allowance.

Claim Objections

In response to the claim objections stated in paragraphs B and C on page 2 of the Office Action under "*Claim Objections*", claims 1, 19, and 20 have been amended as set forth above, and as suggested by the Examiner, to recite "reporter" and "in response to Erk-2 activation". Accordingly, the withdrawal of these objection is respectfully requested.

In addition to these claim amendments, the paragraph heading of the last step of claim 19 is amended to appropriately recite "(h)". Furthermore, step (g) of claim 19 is amended to recite "target compound", for consistency with the remainder of the claim.

10/057,099

-9-

A0000247-01-MG

Withdrawal of the rejections under 35 U.S.C. § 112, first paragraph, is respectfully requested

Claims 1-3, 5, 6, 10 and 19-23 were rejected under 35 U.S.C. § 112, first paragraph; the Office Action indicating that the claims contained subject matter considered to be new matter. This rejection is respectfully traversed.

Page 4 Office Action states that "essential material" may not be incorporated by reference to "(1) patents or applications published by foreign countries or a regional patent office, (2) non-patent publications, (3) a U.S. patent or application which itself incorporates "essential material" by reference, or (4) a foreign application."

However, Applicants submit that the incorporation by reference under consideration, as discussed in detail in Applicants' response of May 10, 2004, is not subject to rejection on the 4 basis stated in the preceding paragraph. The document, WO 9921824, clearly reflects the United States, as a designated country (box (81) of cover sheet). 35 U.S.C. 363 provides that "[a]n international application designating the United States shall have the effect, from its international filing date under article 11 of the treaty, of a national application for patent regularly filed in the Patent and Trademark Office....". Applicants further note that WO 9921824, is now issued as US Patent NO. 6, 635, 673.

As stated in further detail in Applicants' response of May 10, 2004, claims 1 and 19 were amended to include a limitation drawn to "...a test compound that binds to the $\alpha_2\delta$ subunit of a calcium channel...". See step c), claims 1 and 19. Support for this recitation in claims 1 and 19 includes the recitation on page 2, lines 16-20 of the specification, stating "test substances" and "test compound" in the context of screening for gabapentinoid activity; and on page 11, lines 1-3 of the specification which incorporates the publication WO99/21824 by reference, in the context of target compounds to be screened in the assays of the present invention. More particularly, WO '824 provides the statements that "...Gabapentin, binds to the $\alpha_2\delta$ subunit of a calcium channel...", and that "...the compounds of the instant invention also bind to the subunit...". see page 9, final paragraph of the specification. Thus, As stated above, Applicants submit that the Amendments of May 10, 2004, should not be considered as new matter.

10/057,099

-10-

A0000247-01-MG

Applicants further submit that the structures included in the May 10, 2004 amendment of claim 20, should not be deemed to constitute new matter, as page 11, lines 1-3 of the specification states that "Target compounds to be screened in the above described in vitro assay are synthesized as described in international patent application WO 9921824, which is herein incorporated by reference."

Furthermore, as discussed with the Examiner in a telephone interview between the Examiner and the undersigned on September 23, 2004; page 11 of the specification is amended as set forth above, to explicitly incorporate by amendment those sections of WO 9921824 and US Patent NO. 6, 635, 673 which support the amendments of May 10, 2004. It is hereby noted that the content of the quoted portions of the paragraph added by amendment in this paper to page 11 of the present specification is identically disclosed in WO 9921824 and US Patent NO. 6, 635, 673.

In light of all of the above, Applicants submit that no new matter was introduced by the amendment of May 10, 2004. Accordingly, Applicants request that this rejection of the claims under consideration be withdrawn.

10/057,099

-11-

A0000247-01-MG

CONCLUSION

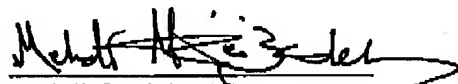
In view of the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order, and such action is respectfully solicited.

The Commissioner is hereby authorized to charge any fees under 37 C.F.R. §§ 1.16 and 1.17 that may be required by this paper to Deposit Account No: 23-0455.

In the event the Examiner wishes to discuss any matter concerning this application, he is welcomed to communicate with the undersigned by telephone.

Respectfully submitted,

Dated: Sept 27, 2004



Mehdi Ganjeizadeh
Registration No. 47,585
Warner-Lambert Company LLC
2800 Plymouth Road
Ann Arbor, MI 48105
Telephone: (734) 622-3831
Facsimile: (734) 622-2928